

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT J. ARNOTT

Appeal No. 2005-2125
Application No. 09/740,854

ON BRIEF

MAILED

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U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before THOMAS, BARRY, and LEVY, Administrative Patent Judges.
LEVY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 2, 4-6, 9, 12-18, 24-26 and 30.

We AFFIRM.

BACKGROUND

The appellant's invention relates to an apparatus and method for establishing a video conference (specification, page 1). Claim 1 is representative of the invention, and is reproduced as follows:

1. A communications device, comprising:

a first interface to a voice channel of a subscriber line for transmitting and receiving a voice component of a video conferencing session;

a second interface to a data channel of the subscriber line for transmitting and receiving a video component of the video conferencing session;

wherein the communications device is configured to establish a connection to at least the data channel based at least in part on a pre-determined signal received via the voice channel.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Huang	6,148,072	Nov. 14, 2000
Mihara	6,323,892	Nov. 27, 2001
Fan	6,519,250	(filed Jul. 29, 1999) Feb. 11, 2003
Bremer et al. (Bremer)	2001/0022836 A1	(filed Apr. 16, 1999) Sep. 20, 2001 (filed Feb. 27, 1998)
Haegebarth (Japanese Patent)	JP2000-092463	Mar. 31, 2000

Claims 1, 2, 13 and 24 stand rejected under 35 U.S.C.

§ 102(e) as being anticipated by Huang.

Claims 4, 5, 26 and 30 stand rejected under 35 U.S.C.

§ 103(a) as being unpatentable over Huang in view of Bremer.

Claims 6 and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Huang in view of Mihara.

Claim 12 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Huang in view of Mihara and Haegelbarth.

Claims 14-18 and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Huang in view of Bremer and Fan.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (mailed June 16, 2004) for the examiner's complete reasoning in support of the rejections, and to the brief (filed May 7, 2004) and reply brief (filed August 16, 2004) for the appellant's arguments thereagainst.

Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered. See 37 CFR § 41.37(c)(1)(vii) (eff. Sept. 13, 2004).

OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the rejections advanced by the examiner, and the evidence of anticipation and obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in

reaching our decision, appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

Upon consideration of the record before us, we make the determinations which follow. We observe at the outset that appellant groups the claims (brief, page 7) as they appear in the rejections. Accordingly, we select claims 1, 4, 6, 12, and 14 as representative of the five groups set forth by appellant. We begin with the rejection of claims 1, 2, 13 and 24 under 35 U.S.C. § 102(e) as being anticipated by Huang.

We turn to claim 1. It is well settled that if a prior art device inherently possesses the capability of functioning in the manner claimed, anticipation exists whether there was a recognition that it could be used to perform the claimed function. See, e.g., In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). Appellant asserts (brief, page 7) that the examiner has failed to understand a key difference between the claimed invention and the prior art because (brief, page 9) Huang teaches voice and video transmissions over two or more separate telephone lines. It is argued (id.) that Huang fails to disclose the transmission of

voice and video components over separate channels of a same subscriber line.

From our review of Huang, we note that Huang discloses (col. 1, lines 21-24 and 32-36) that plain old telephone services (POTS) are the most widely available and least expensive telephone lines, but that they have the disadvantage of a bandwidth limitation. The result of this limitation is that for videophone communications, the image quality and telephone speed is less than desirable. Huang further discloses that it is known to use Integrated Services Digital Network (ISDN) lines to meet the large bandwidth requirements of video communication. Huang adds (col. 1, lines 24-27) that "[i]t is realized that videophones could be more useful if ordinary analog phone lines . . . POTS . . . can be used for videophone communication." Huang further discloses (col. 1, lines 38-42) that a solution proposed by the present inventor is to use multiple lines to increase the total bandwidth with the result that the quality over POTS could be better than the quality over ISDN.

We find from this disclosure that Huang discloses sending voice and data over multiple telephone lines; see also box 720 in figure 3. Thus, the issue becomes whether Huang also teaches

sending both voice and data (video) over a single subscriber line.

From our review of claim 1, we find from the use of "comprising" language as the transitional phrase between the preamble and body of the claim, that the claim does not preclude the presence of more than one subscriber line. However, as asserted by appellant (brief, page 9) the claim requires both the voice channel and the data channel to be on the same subscriber line (from the language "a subscriber line" and "the subscriber line"). Turning back to Huang, the reference discloses in figure 1A a conventional videophone communication system (col. 2, lines 31 and 32 and 60-62) having two videophone systems 522 and 524. A block diagram for a single line system is shown in figure 1B (col. 2, lines 64 and 65). It is disclosed that in figure 1B, because only a portion of the bandwidth of a telephone line is used for audio communication, the other portion can be used for video and control information, and that if videophone system 550 receives data from a remote videophone, multiplexer/demultiplexer 562 is used to separate the combined digital data of the remote videophone. In figure 1A, modem 530 is connected to a telephone line 546. In using the videophone communication system 520 of figure 1A, a user uses telephone set 542 to call the telephone

set of videophone 524. The remote side answers the call, thereby establishing analog voice communication between the two telephone sets. When both sides agree to initiate video communication, digital signal in accordance with H.324 will be generated. H.324 describes a set of procedures to set up channels, etc. prior to actual audio and video communication. This takes approximately 30 seconds to set up (col. 3, lines 6-45). From this disclosure of prior art by Huang, we find that Huang discloses transmitting both voice and data in channels over the same subscriber line 546. In addition, we find from the statement (col. 3, lines 38-40) "[w]hen both sides agree to initiate video communication, digital signal in accordance with H.324 will be generated" and the disclosure (col. 5, lines 16-25) regarding a number passing method, that the connection to at least the data channel is established, based at least in part on a predetermined signal (both sides agree to initiate video communication) received via the voice channel because only analog voice is established at this point (col. 3, lines 36-38).

In addition, we find from the disclosure of Huang (col. 4, lines 30-65) that as disclosed in figure 3, the local and remote telephones first establish analog audio connection using line 1 (state 706); i.e., a user uses videophone 622 to call videophone

624. The dialed number is detected and stored. The caller and receiver then agree to see each other using the videophones. After a user indicates a desire to do video communication, e.g., by pressing a button on videophone 622, videophone modem 644 on line 2 initiates digital dialing (step 708). At the conclusion of the initialization period of step 708, digital mode is established and digitally generated video (voice and images) of the other videophone appears (state 710) on display 636 of videophone 622. Up until this time audio communication between the remote and local telephones remains active on line 1. However, shortly or immediately after the establishment of state 710, modem 630 of line 1 begins to digitally call the modem of the remote telephone and analog audio communication on line 1 is cut off. The telephone number is retrieved from register 618 and modem 630 now undergoes an initiation period (step 718). During step 718, a dual line videophone communication can begin (state 720).

From the disclosure that at the conclusion of step 708, digital mode is established on line 2 and that voice and images of the other videophone appears on display 636 of videophone 622, we find that both the voice and the video are on the same subscriber line e.g., line 2, while analog voice remains on line

1. Thus, for this additional reason, we find that in Huang, both voice and data are sent over the same subscriber line (line 2). Moreover, when both lines are in use, we find that both voice and data are sent over both lines, and Huang does not disclose having voice over one line and video over the second line; i.e., although two or more lines are used, both voice and video are sent over each line. Accordingly, although we agree with appellant's statement (brief, page 12) that "the voice and video transmissions taught by Huang clearly involve **at least two separate telephone lines**," we find that since both voice and video are sent over each line, the limitations of claim 1 are met.

We agree with appellant (brief, pages 14 and 16) that "subscriber line" and "channel" have different meanings, as a subscriber line may have plural channels. We further agree with appellant (brief, page 15) that transmissions over separate channels do not necessarily imply the use of two or more subscriber lines. However, claim 1 requires that the voice channel and the data (video) channel are both on separate channels of the same subscriber line. As stated, supra, we find no language in the claim that would preclude the device of claim 1 from having additional subscriber lines.

We agree with the examiner (answer, page 11) that appellant's disclosed invention is similar to Huang's. However, the fact (*id.*) that "Appellant is using a similar scheme" is not, by itself, evidence of anticipation. It is the precise language of the claims that has to be considered. Accordingly, we agree with appellant (reply brief, page 3) that similarity is insufficient to establish a prima facie case of anticipation.

We not agree with the examiner's statements (answer, page 12) that "[a]ppellant has selectively quoted from his specification to promote his argument about a single subscriber line, which is incorrect as shown here" and "one can see Appellant using two channels/lines to set up a video conferencing session and calls it loosely as a single subscriber line contrary to what is set forth in the specification." From appellant's disclosure (specification, page 9) that "[a]ccordingly, although the first connection 115 and second connection 145 are illustrated separately in FIG. 1, those skilled in the art will realize that they may be one in the same when ADSL or G.Lite is used," we agree with appellant (brief, page 13) that appellant has basis in the specification for both the audio and data channels to be on a single subscriber line. In addition, the examiner's reference to "two channels/lines" implies that

channels and lines are equivalent, which is incorrect, as a line may have plural channels, e.g. a cordless phone which has 10 channels and routes the call to the channel that produces the clearest signal.

However, we do not agree with appellant (reply brief, page 3) that "[s]ince no proof has been put forward to show that Huang does teach the use of a **single subscriber line**, the Examiner has failed to carry his burden of establishing a prima facie case of anticipation." Firstly, Huang's disclosure of prior art in figures 1A and 1B disclose videoconferencing over a single subscriber line. Secondly, in figure 3, when the second line is activated and the audio of the first line is operational, Huang discloses both voice channel and a video channel over the second line. Thirdly, claim 1 does not preclude a second subscriber line as long as both voice and data channels were over the same line. In Huang, when state 720 is reached, both voice and video are sent over both lines. Appellant has not pointed to any teaching in Huang that the voice is sent over one line and the data over the other line, and we are not aware of any such teaching.

From all of the above, we find for the reasons set forth, supra, that Huang anticipates the language of claim 1.

Accordingly, the rejection of claim 1 under 35 U.S.C. § 102(e) is affirmed. As claims 2 and 13 fall with claim 1 (brief, page 7) that rejection of claims 2 and 13 is affirmed.

We turn next to independent claim 24. At the outset, we make reference to our findings, supra with respect to the teachings of Huang, with respect to claim 1. Appellant's arguments for claim 24 are the same as the arguments presented for claim 1. In addition, appellant takes the position (brief, page 7) that claim 24 stands or falls with claim 1. In addition, we observe that notwithstanding appellant's repeated arguments (brief, pages 12, 14 and 19) that claims 1 and 24 require the voice and data channels to be on the same subscriber line, we observe that this limitation does not appear in claim 24. Claim 24 recites "a voice channel of a subscriber line" and "a data channel of a subscriber line." Thus, unlike claim 1, claim 24 allows for voice and data channels to be on either the same or on different subscriber line. In state 720 of Huang, because each line has voice and data, it can be said that one line has voice (and data) and one line contains data (and voice). For this reason, as well as the reasons relied upon for claim 1, the rejection of claim 24 under 35 U.S.C. § 102(e) is affirmed.

We turn next to the rejection of claims 4, 5, 26 and 30 under 35 U.S.C. § 103(a) as being unpatentable over Huang in view of Bremer. We select claim 4 as representative of the group. Appellant asserts (brief, page 24) that while Bremer discloses transmission and reception of multiple telephone services over a single subscriber line, Bremer fails to disclose the transmission of voice and video components of a video conferencing session via separate channels of the same subscriber line, because in Bremer, transmission and reception of voice content as digital data that is transmitted over a digital data channel along with the digitized video content. Claim 4 requires that the voice channel is the PSTN and that the data channel is one of "an asymmetric digital subscriber line (ADSL), a symmetric digital subscriber line (SDSL), a high-data-rate digital subscriber line (HDSL), or a voice-over digital subscriber line (VoDSL)." Although Huang discloses initiating a digital mode on each of lines 1 and 2, Huang is silent as to the type of line used for the data. Bremer discloses simultaneously providing multiple phone services to any/all POTS-type devices on each wire pair (paragraph 8), including a PC or Internet video phone 51. Bremer additionally discloses (paragraph 35) that "[t]he Internet video phone may use either the PSTN or Internet or other land-type

network for data communications. Internet phone 54 has the features of the digital phone with a protocol required for communication over Internet or land networks." Bremer further discloses using both asynchronous digital subscriber line (ADSL) and high bit rate DSL (HDSL) (paragraph 57).

From these disclosures of Bremer, we find that an artisan would have been motivated to use the ADSL or the HDSL for the large bandwidth needed for the transfer of video data in Huang. Note that Bremer's disclosure of providing a Internet video phone over POTS and disclosure of the use of ADSL and HDSL for large bandwidth, we find motivation to use Bremer's ADSL with Huang for data transmission. From all of the above, we affirm the rejection of claim 4. As claims 5, 26 and 30 fall with claim 4 (brief, page 7) the rejection of claims 5, 26 and 30 under 35 U.S.C. § 103(a) is affirmed.

We turn next to the rejection of claims 6 and 9 under 35 U.S.C. § 103(a) as being unpatentable over Huang in view of Mihara. As claims 6 and 9 stand or fall together (brief, page 7) we select claim 6 as representative of the group. Claim 6 requires a charge coupled device (CCD) for capturing the video component transmitted via the data channel. The examiner's position (answer, page 6) is that this feature is suggested by

Mihara, who discloses a CCD camera integrated with a communication device. Appellant's position (brief, page 26) is that Mihara does not make up for the deficiencies of Huang in that neither reference suggests both the voice channel and the video channel are of the same subscriber line. As we found, supra, that this feature of voice and video channels on the same subscriber line is disclosed by Huang. For this reason, and the reasons set forth by the examiner, we are not persuaded of any error in the examiner's position, and affirm the rejection of claim 6. As claim 9 falls with claim 6 (brief, page 7) the rejection of claim 9 under 35 U.S.C. § 103(a) is affirmed.

We turn next to the rejection of claim 12 under 35 U.S.C. § 103(a) as being unpatentable over Huang in view of Mihara and Haegebarth. claim 12 recites that the LCD is used to display advertisements transmitted via the data channel when the voice channel is not transmitting or receiving a voice component. The examiner's position (answer, page 7) is that this feature is suggested by Haegebarth who teaches a method for increasing use of a video conference by using an LCD to display advertisements transmitted via the second channel, when the first channel is transmitting or receiving voice. Appellant's position (brief, page 27) is that neither Huang, Mihara nor Haegebarth suggest

both the voice channel and the video channel are of the same subscriber line. As we found, supra, with respect to claim 1, this feature of both the voice and video channels being on the same subscriber line is disclosed by Huang. In addition, we find that Haegebarth discloses (abstract) "[t]o increase commercial gain from the video telephone and at the same time to attract more user's attention, sound information and/or image information, especially advertisement, is inputted to the 1st channel 7 and/or 2nd channel 8 and reproduced by the video telephone 5, when the corresponding channels 7 and 8 are not used to establish or maintain a connection." From all of the above, we are not persuaded of any error on the part of the examiner, and affirm the rejection of claim 12 under 35 U.S.C. § 103(a).

We turn next to the rejection of claims 14-18 and 25 under 35 U.S.C. § 103(a) as being unpatentable over Huang in view of Bremer and Fan. As claims 14-18 and 25 stand or fall together (brief, page 7), we select claim 14 as representative of the group. The examiner's position (answer, page 8) is that Huang does not show fields in the sent packet. To overcome this deficiency of Huang, the examiner turns to Bremer for a teaching of sending data packet with four fields, and relies upon Fan for a teaching of an internet telephone which sends an IP address and

identifying the type of communication device. Appellant's position (brief, pages 28 and 29) is that none of the applied references recites the voice and video channels being on the same subscriber line. As we found, supra, with respect to claim 1, Huang teaches the feature of the voice and video channels being on the same subscriber line. From our review of Bremer and Fan, we find support for the examiner's position as set forth in the answer. Accordingly, we are not convinced of any error on the part of the examiner, and affirm the rejection of claim 14. As claims 15-18 and 25 fall with claim 14, the rejection of claims 15-18 and 25 is affirmed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 2, 13 and 24 under 35 U.S.C. § 102(e) is affirmed. The decision of the examiner to reject claims 4-6, 9, 12, 14-18, 25, 26 and 30 under 35 U.S.C. § 103(a) is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED

JAMES D. THOMAS)
Administrative Patent Judge)
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Appeal No. 2005-2125
Application No. 09/740,854

Page 19

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